

**REMARKS**

Claims 1-46 are pending in the present case. No claim is allowed.

**Record of Interview**

On January 15, 2002, an interview was conducted by telephone between the Examiner and Steven J. Robbins, Reg. No. 40,299. The Examiner is thanked for granting this interview.

The Office Action of October 29, 2001 was discussed, particularly the 35 U.S.C. § 103 rejection of claims 1 and 13. Attempts were made to gain insight into the respective positions of each party in the hope of finding common ground. No agreement was reached.

**The 35 U.S.C. § 103 Rejection**

Claims 1, 2, 4-15, 17-28, 30-38, 40-43, 45, and 46 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hogan et al.* in view of *Lindholm*. Claim 44 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hogan et al.* in view of *Lindholm* in further view of *Nakagawa et al.*. Claims 3, 16, 29, and 39 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hogan et al.* in view of *Lindholm* in further view of *Gish*. These rejections are respectfully traversed.

Specifically, the Office Action states that *Hogan* discloses or suggests most of the claim limitations and that *Lindholm*, *Nakagawa*, and *Gish* disclose or suggest the remaining claim limitations. However, each and every element as set forth in the present claims are not found in or suggested by the cited prior art. Furthermore, the various combinations of elements proposed by the Office Action are never arranged by the cited prior art in the same manner as proposed by the Office Action or as required by the present claims. The laundry list of citations are often incorrect or inconsistent with one another.

It is well established, according to M.P.E.P. § 2141.01, that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." This is a two part test, that is, first field of endeavor and second problem of concern. It should be highlighted that the field of endeavor and the problem of concern must be *mutual* to the reference and the Applicant. One should not graft one into the other. If they are not mutual, then the elements of the reference are merely being selected based on impermissible hindsight. This can be especially problematic when a term in one context may not have exactly the same meaning as the same term in another context. Further, implicit in the requirement above is that it provide some limitation to the knowledge imparted to the archetypical "one of ordinary skill in the art." For example, according to the Constitution all patents "promote the progress of useful arts", but if one were to use this to meet the above requirement, it would render the requirement void. By definition, all patents are in this group making no distinction between one patent and any other. This would make the skilled artisan virtually omnipotent which can hardly be considered ordinary in any sense of the word.

Perhaps less well established but equally as true is that computer software and hardware encompass a wide array of methods and apparatus. Although some generalizations are possible, one should be careful before making such statements. Especially where patents are concerned, there is often much detail that is provided in the disclosure that would be lost in overly broad statements as to the field of endeavor or the problem of concern. Further, the limitation function of the § 2141.01 requirement becomes severely limited.

According to page 1, lines 5-6 of the present application, "[t]his invention relates to computer networks, and more particularly provides a system and method for managing a network device from a remote client." Consequently, the Applicant's field of endeavor is "computer networks" and the problem of concern is "managing a network device from a remote client."

An examination of *Hogan* reveals that "[t]he present invention relates generally to a Multi-Cross Platform Repository System for real-time embedded software, and more particularly, the present invention provides the means to fully characterize, evaluate, and reuse real-time embedded software that is placed or stored in a repository database." (Col. 1, lines 6-11) Consequently, *Hogan's* field of endeavor is "Repository System[s]" and the problem of concern is "provid[ing] the means to fully characterize, evaluate, and reuse real-time embedded software." One will recognize that the Applicant and *Hogan* differ in these regards. Moreover, it is informative to examine these aspects of *Hogan* further. First, while it is true *Hogan* employs or involves a computer network, this is not his primary concern. The focus is the repository server. He assumes that the network will serve his needs. He makes no special attempt to design or manage the network in any appreciable way. Second, it is significant to note that *Hogan* does not design or use the embedded software. His emphasis is on making existing designs visible to those who might have use for them. *Hogan* believes that embedded software can and will be reused if an embedded device designer can more easily view what is available. *Hogan* does not include himself in the group of embedded device designers. He believes that his invention is generally applicable to all embedded software no matter what function the software may serve after being embedded in the designer's device. Further, *Hogan* does not specify which device will be embedded with the software.

A similar examination of *Lindholm* reveals that "[t]he present invention relates to computer systems and methods for executing programs with reduced run-time memory space requirements. In particular, the *Lindholm* pertains to computer systems and methods in a network for executing code transmitted over the network (i.e., network mobile code) so that the

some regard even if it is not their focus. The result of the application of the generalization given would be that virtually all computer related patents would be considered appropriate for combination under § 2141.01. This is not and should not be the case.

It is also well established, according to M.P.E.P. § 2141.02, that "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious." Although the subject of the test is the claims, the invention as a whole that is being claimed should be commensurate with and reflective of the field of endeavor and the problem of concern. Furthermore, the cited elements from the prior art should be as well. Merely collecting elements from various references is not sufficient and constitutes impermissible hindsight reconstruction. If the cited reference does not share the same focus, then it is more difficult to combine the references or achieve the claimed invention as a whole. For example, if the reference teaches one how to travel from point A to point B, then one would not expect to end up at point C as claimed. Possible exceptions to this rule would be that the claims are broad enough to encompass unrelated or multiple inventions and that the claimed invention is inherent in the prior art as a tool to achieve a different focus. For example, the claim includes both points B and C or the reference teaches that in order to travel to point B one would first travel to point C.

As noted above, the references as a whole are directed to different fields of endeavor and problems of concern. They start at different points and end at different points. Given their lack of disclosure about networks, it should not be surprising that the references do not inherently

disclose the claimed invention individually or in combination. The primary conclusion that can be drawn is that the cited references as a whole do not make the claimed invention obvious.

A review of the Abstract of the present application should provide a basis of understanding of the invention before specific review of the rejections is undertaken. In general, the invention includes both the design of the network with new features and the utilization of those new features. First, as variously claimed,

A manufacturing method enables the manufacture of remotely controlled network device management system. The manufacturing method includes the steps of obtaining a software program, obtaining a downloadable unit (e.g. an applet) configured to communicate with the software program, compiling the software program into a binary file, embedding the downloadable unit into the binary file, and loading the binary file with the embedded downloadable unit onto the network device.

Depending on the circumstances, the software program may be obtained from the network device and returned to the network device or the software program may be new to the network device.

In either case, the result is a network device that has been loaded with a binary file that is embedded with a downloadable unit. In this context, the network device may include, among others, a web server, a router, or any networked computer. Second, as variously claimed,

A management method enables a remote client to manage the network device. The management method includes the steps of receiving from a remote client a request to manage a software program which has a binary file with an embedded downloadable unit, locating the downloadable unit embedded in the binary file, extracting the downloadable unit from the binary file, and forwarding the downloadable unit to the remote client.

Implicit in the above are the facts that the remote client is one that knows that the specific network device exists, knows that they have an interest in managing the network device, and knows what operation they want to perform on the network device, however they do not have the specific mechanism to manage the network device. Further, the remote client knows that if they contact the network device then the network device itself will provide them with the mechanism

that they lack. In this context, the remote client is not typically the average network user but is a network professional charged with establishing and maintaining the network that includes the network device.

With respect to this last point about the user of the present invention, it is interesting to note that this is in contrast to the users of either *Hogan* or *Lindholm*. *Hogan* is directed to a wide range of users including technologically unsophisticated users from marketing and accounting. (See FIG. 10 and col. 19, line 19 through col. 20, line 20) This is because *Hogan* is primarily interested in bringing visibility to embedded software stored on the repository server. The operation of the repository server is transparent to the users. Likewise, *Lindholm* is directed to the average computer user including video game users and cellular phone users. (See col. 5, lines 6-9) Similarly, the invention is transparent to both the designer and the user of the AN code. In either case, the users may not be as technologically sophisticated as those of the present invention. The primary conclusion that can be drawn is that the selection and combination of the cited references to make the claimed invention may not be appropriate.

The Office Action dated July 25, 2001 recognizes that "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." It goes on to state that, "[i]n this case, motivation although not required, may be found in the applied reference, see *Lindholm*, col. 2 lines 10-19." It is uncertain whether this citation is intended to provide motivation for the modification of *Hogan*, the combination of *Hogan* and *Lindholm*, or both. In any case, the citation discusses the virtues of using AN code in general.

However, two paragraphs later, *Lindholm* then points out problems with the prior art as he has identified it in the cited passage. His invention is designed to solve these problems. It is therefore unlikely that the citation would be used by *Lindholm* to support any modification of or combination with *Hogan*. The primary conclusion that can be drawn is that without proper motivation, obviousness has not been established.

In the Response dated August 15, 2001, the specifics of the rejection regarding claims 1, 13, and 27 was examined as an example. That review has not been responded to in detail and is not being withdrawn. Three specific issues that were highlighted in the Examiner interview will be discussed again and in further detail below.

First is the issue of whether or not, the repository units of *Hogan* are "embedded" as claimed. If they are embedded, then one should be able to identify where they are embedded. A review of FIG. 2 of *Hogan* provides three possible embedding locations, that is, a server 7, 10, 12, 13, a repository 7a, 10a, 11a, 12a, 13a, and a repository client 8, 9, 11. *Hogan* notes that by its nature software that has been embedded "...is not visible to the end user because it is completely contained within the product. Such software is also generally not visible to the company that developed it." (Col. 1, lines 20-23) This is what drives him to design his invention to provide visibility to embedded software. If as suggested the repository units were embedded anywhere in FIG. 2 then they would become *invisible* and thereby destroy the purpose of the invention. As noted above, the repository units are merely "placed or stored in the repository database." Further, if as may be suggested, the repository units were embedded at the repository client then they would either not be remote from the client or not be on a network device. The Applicant contends that in fact the examples given by *Hogan* suggest that the

repository units are not embedded on any of the network devices shown but rather are embedded in "...end user products such as cellular phones, ATM switches, and anti-lock brake systems." (Col. 1, lines 17-18) *Hogan* is simply not interested in building a better network utilizing the repository units. The Repository System is akin to a software warehouse or catalog. The Repository System aids in the creation of embedded devices, it is not an embedded device itself.

Second is the issue of whether the repository units of *Hogan* are "configured to...enable the remote client to remotely configure the network device" as claimed. As noted above, under the present invention the assumption is that during use of the network the remote client does not have the downloadable unit needed to configure the network device. This is why the remote client initially contacts the network device. To the contrary, *Hogan* discloses that the "[u]sers access the Repository Servers using Repository Client software. The Repository Client comprises a Repository Server access software set that provides the user with a full set of capabilities to interact with the Repository Server." (Col. 16, lines 7-10) Under *Hogan*, the Repository Client has everything that they need to interact with the network. They are simply employing the network to look for embedded software for their "...cellular phones, ATM switches, and anti-lock brake systems." The repository units of *Hogan* do not serve a network function for the Repository Client. Further, since, as noted above, the Repository Client is not a network professional, *Hogan* would not want them to be configuring his network devices. They are not qualified or authorized to do so. Consequently, the Repository Client software merely allows "access" and not the ability to configure the network devices.

Third is the issue of whether the repository units of *Hogan* include "a communicator component...an interface component...and a configuration component" as claimed. The Office



Action cites "the downloadable unit including a communicator component...(col. 21/lines 1-10), an interface component...(col. 8/lines 15-18, col. 5/lines 12-20, col. 16/line 6-39, col. 6/lines 43-44), and a configuration component...(col. 16/lines 37-63, col. 5/lines 12-15)." The first citation is to the "RTES Application Player Desktop utility" that is included on the "Repository Client (and Repository Station)". (Column 20, lines 63-64) The second citations include the "Repository Client", non-enabling objects of the invention, "Repository Server access software", and a non-enabling and vague one line summary. The third citations include the "Application Player" which is also included in the "Repository Client and Repository Station" (Column 16, lines 29-36) and a duplicate from above of one of the non-enabling objects of the invention. In every case, the citations are not to repository units which were previously equated with the downloadable unit claimed. In order for the rejection to remain consistent, the citations must be to the repository units and not just to random elements. Further, the citations are to devices other than the Repository Server which was equated with the network device claimed. Here, in order for the rejection to remain consistent, the citations must be to the Repository Server and not just to random elements. In both regards, the citations are not as claimed and are inconsistent.

The same inaccuracies and inconsistencies are applied to all of the claims either by reference to the above rejection or by substantially identical citations.

The additional citation of any or all of *Lindholm*, *Nakagawa*, and *Gish* does not remove the above problems. Given these differences, the cited prior art cannot be said to make the present invention obvious. In view of the above, it is respectfully asserted that the claims are now in condition for allowance.

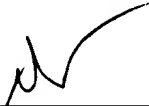
Request for Allowance

In view of the foregoing, reconsideration and an early allowance of this application are earnestly solicited.

If any matters remain which could be resolved in a telephone interview between the Examiner and the undersigned, the Examiner is invited to call the undersigned to expedite resolution of any such matters.

Respectfully submitted,  
THELEN, REID, & PRIEST LLP

Dated: January 25, 2002

---

David B. Ritchie  
Reg. No. 31,562

Thelen, Reid, & Priest LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
(408) 292-5800